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PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
05725.1017

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on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/060,234	**February 1, 2002**

First Named Inventor
Jean-Louis H. GUERET

Art Unit	Examiner
3751	**H. Le**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.
Registration number **38,742**.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Kyongtack K. M (Reg. No. 50,585)
Signature

for **Anthony M. Gutowski**
Typed or printed name

571-203-2774
Telephone number

August 11, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of **1** forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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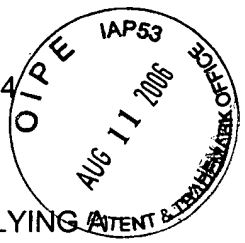
PATENT
Customer No. 22,852
Attorney Docket No. 05725.1017

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Jean-Louis H. GUERET	)	Group Art Unit: 3751
	)	
Application No.: 10/060,234	)	Examiner: H. LE
	)	
Filed: February 1, 2002	)	
	)	
For: DEVICE FOR APPLYING A PRODUCT	)	Confirmation No.: 8084
	)	



Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, a Petition for a one-month extension of time, and completed Form PTO/SB/33 filed concurrently herewith, Applicant respectfully requests a pre-appeal brief review of this application.

Claims 1, 3-9, 11-83, 85-108, 110, 112-116, 118-121, 123-128, 130-133, 135-156, 158-182, 184-192, 194-199, 201-204, and 206-214 are pending in this application, with claims 1, 71, and 144 being independent. Of those pending claims, claims 18-21[1], 52-59, 68, 69, 92-95, 124-128, 130, 131, 142, 143, 165-168, 195-199, 201, 202, 213, and 214 have been withdrawn from consideration as being allegedly drawn to non-elected species.

[1] The Office Action Summary indicates claims 8-21 as being withdrawn from consideration. As is clear from the record, however, only claims 18-21, rather than claims 8-21, have been withdrawn from consideration. Therefore, Applicant will continue to treat claims 1, 3-9, and 11-17 as having been considered by the Examiner.

In the Office Action mailed April 14, 2006 ("Office Action"), all of the pending claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,549,835 to Gray ("Gray") in view of U.S. Patent No. 4,519,795 to Hitchcock, Jr. et al. ("Hitchcock"). For at least the following reasons, this rejection should be withdrawn.

Applicant's independent claims 1, 71, and 144 each recite, among other things, a "first portion defining a recess," "a second portion moveable with respect to the first portion so as to selectively place the device in one of a closed position and an open position," and "an application member attached to the second portion."

Gray discloses a method for making sachets having a pocket 5 between a top foil 1 and a bottom foil 4. The method includes placing a measured amount of liquid into a depression in the bottom foil 4 and placing a sponge 10 into the depression. The top foil 1 is then placed over the depression containing the liquid and sponge 10, and the top foil 1 is sealed to the bottom film 4 around the edges (i.e., shoulder 6) so as to form the sachet having the pocket 5. The sachet is configured to be opened by tearing both the top and bottom foils 1, 4 at a V-notch 11.

In the Office Action, the Examiner admitted that "Gray does not disclose that the application member 10 is attached to the second portion 1 by bonding." Nevertheless, the Examiner alleged that Hitchcock "teaches another application device having a pad 14 attached to a plastic strip 12 by an adhesive (col. 2, lines 45-49)" and that, therefore, "it would have been obvious ... to modify the sachet device of Gray by attaching the application member to the second member (top foil 1) in view of the teaching of the Hitchcock Jr. reference in a way such that when opening the sachet, the top foil can be [peeled] off and used as a handle to apply the product on a user without soiling a user's hand." Applicant respectfully disagrees with the Examiner's allegations.

The Examiner has the initial burden of presenting a *prima facie* case of unpatentability. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria

must be met. First, the prior art references when combined must teach or suggest all of the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See, e.g., M.P.E.P. § 2143. Furthermore, case law in this context indicates that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and that the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." As explained below, the Examiner's alleged combination of Gray and Hitchcock fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

In particular, as to the second criterion, there is no suggestion or motivation in either Gray or Hitchcock to modify the alleged teachings of Gray and Hitchcock in the manner proposed by the Examiner. For example, in stating that "it would have been obvious ... to modify the sachet device of Gray ... in view of the teaching of the Hitchcock, Jr. reference in a way such that when opening the sachet, the top foil can be [peeled] off and used as a handle to apply the product on a user without soiling a user's hand," the Examiner is essentially alleging that it would have been obvious to modify Gray's device in such a way that Gray's device can have the alleged features of Hitchcock (i.e., a handle to apply the product on a user without soiling a user's hand). As is abundantly clear, the Examiner's allegation is nothing more than a conclusory statement based on impermissible hindsight gleaned from Applicant's disclosure and does not provide any "clear and particular" or otherwise legally sufficient reason as to why the alleged features of Hitchcock would have been desired by one of ordinary skill in the art considering Gray's device. When Gray and Hitchcock are viewed as a whole without such hindsight, the alleged combination of Gray and Hitchcock would not have been suggested since there were no "clear and particular" suggestion or motivation to make the Examiner's proposed combination or modification.

Moreover, one of ordinary skill in the art considering Gray's device would not have been motivated to attach the sponge 10 to the top foil 1 because Gray and Hitchcock teach away from doing so. For example, the sachet of Gray is made from a flexible and thin material so that, when vacuum is applied, it can be deformed to compress the sponge 10 contained therein. However, Hitchcock requires the strip 12, to which its pad 14 is attached, to be sufficiently stiff so that it can be folded into a structure that serves as a handle, as best shown in Figs. 3 and 4. As is abundantly clear, the top foil 1 of Gray, being sufficiently flexible and thin, would not be suitable for serving as a handle. In addition, the top foil 1 of Gray does not include any additional structure to serve as a handle structure. In fact, the mass production advantage (e.g., a continuous process carried out in which pockets are produced by placing two continuous webs of film or foil over one another) disclosed in Gray at col. 2, lines 24-35, teaches away from having such an additional structure. For at least these reasons, one of ordinary skill in the art would not have been motivated to take any of the alleged teachings of Hitchcock and apply them in the device of Gray.

Furthermore, attaching the sponge 10 of Gray to the top foil 1 in the manner suggested by the Examiner would have destroyed the usefulness and function of the V-notch 11 of Gray. For example, the top foil 1 and the bottom foil 4 are sealed together on the shoulder 6 to form a sachet. Thus, to remove the sponge 10 out of the sachet, Gray provides the V-notch 11 to create an opening on a side of the sachet, through which the sponge 10 can be removed (see col. 3, lines 22-23, and Fig. 1 of Gray). If, however, the sachet of Gray were modified to attach the sponge 10 to the top foil 1, the opening created by the V-notch 11 would be insufficient to remove the sponge 10 out of the sachet and would require an additional opening (e.g., separating the top foil 1 and the bottom foil 4 from one another at the shoulder 6) without affecting the structural integrity of the top foil 1 that is to be used as a handle. Thus, attaching the sponge 10 to the top foil 1 in the sachet of Gray would necessarily destroy the usefulness and function of the V-notch 11. Moreover, tearing the sachet along the V-notch 11 would affect

the structural integrity of the top foil 1, which is to be used as an applicator handle, and would render the V-notch 11 completely useless, thereby destroying the teachings of Gray.

For at least the reasons set forth above, a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been properly established. Therefore, the Examiner's 35 U.S.C. § 103(a) rejection based on the alleged combination of Gray and Hitchcock is in error and should be withdrawn.

Applicant respectfully requests reconsideration of this application, withdrawal of the outstanding 35 U.S.C. § 103(a) rejection, and allowance of all pending claims.

Since independent claims 1, 71, and 144 are generic and allowable, withdrawn dependent claims 18-21, 52-59, 68, 69, 92-95, 124-128, 130, 131, 142, 143, 165-168, 195-199, 201, 202, 213, and 214 should be rejoined and allowed for at least the same reasons that their corresponding independent claim is allowable.

Please grant any extensions of time required to enter this request and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 11, 2005

By: _____ (Reg. No. 51,585)
for Anthony M. Gutowski
Reg. No. 38,742